



07-12-04

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PTO/SB/21 (08-00)

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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)		Application Number	10/828,594
		Filing Date	April 21, 2004
		First Named Inventor	Luxem, et al.
		Group Art Unit	To Be Assigned
		Examiner Name	To Be Assigned
Total Number of Pages in This Submission	9	Attorney Docket Number	1895-14998US02

**ENCLOSURES (check all that apply)**

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> PTO 1449/08A with references <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) ( sheets) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		Enclosed: Petition Under 37 CFR 1.53(e)(2) to be Accorded Filing Date; Preliminary Amendment; Copy of Original Return Receipt Postcard; Return Receipt Postcard for Present Transmittal

**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm or Individual Name	McAndrews Held & Malloy, Ltd.		
Name (Print/type)	Christopher M. Scharff	Registration No. (Attorney/Agent)	53,556
Signature	<i>Christopher Scharff</i>		Date: July 9, 2004

**EXPRESS MAIL DEPOSIT**

"Express Mail" mailing label number : EV 435260483 US  
Date of Deposit July 9, 2004.



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# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 130.00

## Complete if Known

Application Number	10/828,594
Filing Date	April 21, 2004
First Named Inventor	Luxem, et al.
Examiner Name	To be Assigned
Art Unit	To be Assigned
Attorney Docket No.	1895-14998US02

## METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money ☐ Other ☐ None  
Order

☐ Deposit Account:

Deposit  
Account  
Number 13-0017

Deposit  
Account  
Name McAndrews, Held & Malloy, Ltd.

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments  
☐ Charge any additional fee(s) during the pendency of this application  
☐ Charge fee(s) indicated below, except for the filing fee  
to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$ ) 0

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		-20 **	=	0	X		=	0
Independent Claims		-3 **	=	0	X		=	0
Multiple Dependent					X		=	0

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ ) 0

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) Petition Fee under 37 CFR 1.17(h)

130.00

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ ) 130.00

## SUBMITTED BY

Name (Print/Type)	Christopher M. Scharff	Registration No. (Attorney/Agent)	53,556	Telephone	(312) 775-8039
Signature		Date	July 9, 2004		

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing this form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.



ATTORNEY DOCKET  
(1895-14998US02)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of: **Franz J. Luxem,**  
**William M. Troy**

Serial No.: **10/828,594**

Filed: **April 21, 2004**

For: **METHOD OF MAKING ALKYL  
ESTERS**

Examiner: **To be Assigned**

Group Art Unit: **To be Assigned**

CERTIFICATE OF MAILING

I hereby certify that this correspondence is  
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Commissioner of Patents, P.O. Box 1450,  
Alexandria VA, 22313-1450 on.  
July 9, 2004

Express Mail No: EV 435260483 US

By:

Christopher M. Scharff  
Christopher M. Scharff

Reg. No. 53,556

Mail Stop Petitions  
Commissioner of Patents  
P.O. Box 1450  
Alexandria VA, 22313-1450

PETITION UNDER 37 C.F.R. §1.53(e)(2) TO BE ACCORDED  
FILING DATE AND FILING RECEIPT

Dear Sir:

Applicants respectfully petition under 37 C.F.R. §1.53(e)(2) that the original filing date of April 21, 2004 be accorded to the above-referenced patent application. A Notice of Incomplete Nonprovisional Application was mailed by the OIPE on July 1, 2004, contending that the application was deficient for not including drawings. However, Applicants respectfully submit that drawings are not necessary for the understanding of the subject matter sought to be patented, under 35 U.S.C. §113 (first sentence).

Specifically, all of the claims of the present application are directed to methods for making alkyl esters or products produced according to those methods. MPEP §608.02 states that:

An OIPE formality examiner should not treat an application without drawings as incomplete if drawings are not required. A drawing is not required for a filing date under 35 U.S.C. 111 and 113 if the application contains:

- (A) at least one process claim including the term “process” or “method” in its introductory phrase;
- (B) at least one composition claim including the term “composition,” “compound,” “mixture” or “pharmaceutical” in its introductory phrase.

\* \* \* \*

In the present application, every claim is directed to either a method or product made according to a claimed method, and therefore, drawings are not required.

It appears, however, that the Notice of Incomplete Nonprovisional Application was sent by the OIPE because the specification as filed incorrectly made reference to eight missing figures. The references to these eight figures, however, stated that they described testing results and properties only, and therefore were not necessary for the understanding of the invention. Accordingly, Applicants also include with this petition an Amendment to the Specification, to delete the references to the figures in the specification. Applicants believe that this Amendment, in light of the claims as filed (which include at least one process claim), satisfy the OIPE’s Notice, and respectfully request that the original filing date of April 21, 2004 be accorded to this application.

In the alternative, the Applicants respectfully submit that the OIPE incorrectly refused to accord this application a filing date, notwithstanding the references in the specification to the missing unnecessary figures. MPEP 606.01(f) states:

“A nonprovisional application having at least one claim, or a provisional

application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP §601.01(g), so long as the application contains something that can be construed as a written description. (emphasis added).

Accordingly, MPEP 601.01(g) states that a Notice of Omitted Items should have been mailed, rather than a Notice of Incomplete Nonprovisional Application, and a filing date should have been accorded to this application. Applicants would have then had the option of accepting the application as deposited in the USPTO, without the referenced drawings, but retaining the original filing date. Applicants could then amend the specification in the same way to delete reference to the missing, unnecessary drawings.

Therefore, under either basis, Applicants respectfully petition the Commissioner to accord the instant application the original filing date of April 21, 2004, and respectfully request a filing receipt which so reflects. Additionally, Applicants enclose the required petition fee of \$130.00 under 37 C.F.R. §1.17(h), and proof of original filing, but request that the fee be refunded and credited to Deposit Account No. 13-0017, in the name of McAndrews, Held & Malloy, Ltd., upon grant of the petition.

Respectfully Submitted,

A handwritten signature in black ink, reading "Christopher Scharff". The signature is written in a cursive, flowing style with a long, sweeping underline.

Christopher M. Scharff  
Attorney for Applicants  
Reg. No. 53,556  
MCANDREWS, HELD & MALLOY, LTD.  
500 West Madison St.  
34<sup>th</sup> Floor / Suite 3400  
Chicago, IL 60661  
(312) 775-8039



ATTORNEY DOCKET  
(1895-14998US02)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of: **Franz J. Luxem,**  
**William M. Troy**

Serial No.: **10/828,594**

Filed: **April 21, 2004**

For: **METHOD OF MAKING ALKYL  
ESTERS**

Examiner: **To be Assigned**

Group Art Unit: **To be Assigned**

CERTIFICATE OF MAILING

I hereby certify that this correspondence is  
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addressed to: Mail Stop Petitions,  
Commissioner of Patents, P.O. Box 1450,  
Alexandria VA, 22313-1450 on.  
July 9, 2004

Express Mail No: EV 435260483 US

By: *Christopher Scharff*  
Christopher M. Scharff

Reg. No. 53,556

Mail Stop Petitions  
Commissioner of Patents  
P.O. Box 1450  
Alexandria VA, 22313-1450

PRELIMINARY AMENDMENT

Dear Sir:

In connection with the attached petition under 37 C.F.R. §1.53(e)(2), to be accorded the  
filing date of April 21, 2004, the Applicants request entry of the following amendment to remove  
reference to unnecessary Figures 1-8.

**Amendments to the Specification begin on page 2.**

**Amendments to the Specification:**

Please amend the specification as follows:

On page 3, please delete paragraphs 0012-0015;

On page 4, please delete paragraphs 0016-0019;

On page 8, please amend paragraph 0034 as follows:

~~Figures 3 to 6 further demonstrate the transesterification of glycerides in Run 1. Figure 3 shows the results for a  $^1\text{H}$ -NMR for acidulated soap stock. Figure 4 shows the results for a  $^1\text{H}$ -NMR for a known biodiesel reference. Figure 5 shows the results for a  $^1\text{H}$ -NMR for Run 1 at 15 minutes. Figure 6 shows the results for a  $^1\text{H}$ -NMR for Run 1 at 120 minutes. Comparison of  $^1\text{H}$ -NMR for acidulated soap stock, known biodiesel reference, and Run 1 at 15 and 120 minutes the graphs of Figure 3 through 6 illustrates the reduction in the presence of glycerides and an increase in the presence of methyl esters showed that glycerides were reduced and methyl esters were increased.~~

On page 17, please amend paragraph 0052 as follows:

~~Figures 7 and 8 show the results for a  $^1\text{H}$ -NMR for Runs 6 and 7, respectively. Figures 7 and 8  $^1\text{H}$ -NMR results for Runs 6 and 7 did not reveal any side reactions taking place under the conditions of the reaction scheme, indicating that the reaction scheme of the present invention may be the subject of a continuous process. Additionally,  $^1\text{H}$ -NMR for Run 7~~Figure 8 confirmed that the higher reaction temperature of Run 7 does not have a negative effect as far as decomposition is concerned.



**CONCLUSION**

Applicants respectfully request entry of the foregoing preliminary amendment to the specification. Please charge any additional fees or credit any overpayment to Deposit Account No. 13-0017, in the name of McAndrews, Held, & Malloy, Ltd.

Respectfully Submitted,

Christopher M. Scharff  
Attorney for Applicants  
Reg. No. 53,556  
MCANDREWS, HELD & MALLOY, LTD.  
500 West Madison St.  
34<sup>th</sup> Floor / Suite 3400  
Chicago, IL 60661  
(312) 775-8039





ASSISTANT COMMISSIONER FOR PATENTS

Sir: Please place the USPTO receipt stamp hereon and place in outgoing mail to acknowledge receipt of:

Docket No: 1895 - 14998US02

Applicant: Luxem, et al.

Serial No.: To Be Assigned

Filed: April 21, 2004

☒ Transmittal

☒ Fee \$ 918 ~~925.00~~

☒ Patent Application including:

12 Page(s) Cover Sheet

12 Page(s) Specification

5 Page(s) Claims # 1-32

1 Page(s) Abstract

0 Page(s) Drawings Formal Informal

Response to Notice of Missing Parts

☒ Declaration & POA Signed Unsigned

Amendment     Page(s)

☒ Assignment 4 Page(s) Cover Sheet 1 Page(s)

    IDS with PTO-1449     Page(s)

    Cited References

☒ Other POA by Assignee & 37 CFR 3.73

Certification

   

   

    Certificate of Mailing as dated below

☒ Certificate of Express Mailing as dated below

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Dated: 4-21-04

Respectfully: **McANDREWS, HELD & MALLOY, LTD.**

Attorneys for Applicant

